

**REMARKS**

By this amendment, Applicants: cancel claim 12; and amend claim 9 to correspond to original claim 12, and claims 13-14 to depend from claim 9 rather than claim 12.

Accordingly, claims 9-11, 13-14 and 21-23 remain pending in the application.

Reexamination and reconsideration of the application are respectfully requested in view of the remarks below.

**35 U.S.C. §§ 102 and 103**

The Office Action rejects claim 9 under 35 U.S.C. § 102 over Todokoro et al. U.S. Patent 5,594,245 ("Todokoro"), and claims 10-14 and 21-23 under 35 U.S.C. § 103 over Todokoro in view of Masnaghetti et al. U.S. Patent 6,066,849 ("Masnaghetti").

Applicants respectfully traverse those rejections for at least the following reasons.

**Claim 9**

Among other things, the method of claim 9 includes providing a reference graph which shows a change in the amount of secondary electrons detected in a standard state where the conductive layer is exposed with respect to a number of scans of primary electrons.

The Office Action fairly admits that both Todokoro and Masnaghetti fail to disclose any such reference graph.

Yet, without any support or citation to anything in the prior art, the Office Action just states that such a feature would have "obviously minimized operator error."

Applicants traverse this statement, and the proposed combination of Todokoro and Masnaghetti, as lacking support in either the law or the facts.

M.P.E.P. § 2143 provides that:

*“The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant’s disclosure.”*

Furthermore, M.P.E.P. § 2144.03 provides that:

*“there must be some form of evidence in the record to support an assertion of common knowledge. See In re Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).”*

(Emphasis added). See also In re Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34 (Fed. Cir. 2002) (the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record.).

Here, the motive suggested by the Office Action is apparently a hindsight rationale for a modification not found anywhere in the prior art. The Office Action does not point to anywhere in the cited references with the purported motive is given, nor did the Examiner submit an affidavit as required by 37 CFR 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants request such an affidavit if this rejection continues to be maintained based a motive for combination not explicitly suggested in the prior art.

Otherwise, Applicants respectfully submit that claim 9 is patentable over the prior art.

Claims 10-11 and 13-14

Claims 10-11 and 13-14 depend from claim 9 and are deemed patentable for at least the reasons set forth above with respect to claim 9.

Claim 21

Among other things, the method of claim 21 includes collecting secondary electrons that are generated by a reaction between the primary electron beam and an inside surface of the contact hole and that are emitted from the contact hole for each of the N scans; and determining whether a surface of the conductive layer is exposed through the contact hole in the insulating layer pattern based on a change in an amount of collected secondary electrons as a function of the N scans.

Applicants respectfully submit that both Todokoro and Masnaghetti fail to disclose any such features, and therefore no possible combination of Todokoro and Masnaghetti could produce a method including such features.

Accordingly, for at least these reasons, Applicants respectfully submit that claim 21 is patentable over any combination of Todokoro and Masnaghetti.

Claims 22-23

Claims 22-23 depend from claim 21 and are deemed patentable over Todokoro and Masnaghetti for at least the reasons set forth above with respect to claim 21.

**CONCLUSION**

In view of the foregoing explanations, Applicants respectfully request that the Examiner reconsider and reexamine the present application, allow claims 9-11, 13-14 and 21-23, and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283-0724 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and

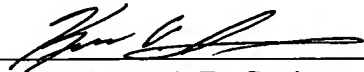
future replies to charge payment or credit any overpayment to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

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By: \_\_\_\_\_



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